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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,605	07/24/2003	Alberto Peisach	60783.000005	7920

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EXAMINER	
BECK, DAVID THOMAS	

ART UNIT	PAPER NUMBER
1732	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/625,605	PEISACH ET AL.	
	Examiner	Art Unit	
	David T. Beck	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) *1-14* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11/10/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Applicant is advised that should claim 18 be found allowable, claim 16 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 28 states that the container is to be made of up to about 15 volume % ethylene vinyl acetate-vinyl alcohol, about 80 to about 90 volume % polypropylene and about 15 to about 20 volume % adhesive. However, the invention cannot be practiced as claimed because if the container is made of 80% polypropylene and 15% adhesive, the most ethylene vinyl acetate-vinyl alcohol that could be added is 5%, not up to 15 volume % as claimed.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 15 and 18 both recite the limitation "wherein further the inward flexing of the bottom surface **of** the container wall reduces a pressure differential..." (emphasis added). There is insufficient antecedent basis for this limitation in the claim. The claims detail a bottom surface or a container wall, but do not describe a bottom surface of a container wall. For the purposes of examination, the examiner interprets the claims as meaning "wherein further the inward flexing of the bottom surface **or** the container wall reduces a pressure differential...". Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 15-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Jonas et al (5,234,126).

With regard to claim 15, Jonas et al teach a method for forming a plastic container (abstract), comprising: selecting at least one polymer for a plastic container (column 13, lines 57-68); and forming the plastic container (column 14, lines 1-5); wherein the plastic container comprises: a mouth; a bottom surface; and a container wall between the mouth and the bottom surface (column 8, lines 59-68), wherein one of the bottom surface or the container wall flexes inward into the cavity of the plastic container (column 5, lines 19-27); wherein further the inward flexing of the bottom surface of the container wall reduces a pressure differential between the inside of the container and atmospheric pressure when either the container is hot-filled with food product or when the container is transported from a locale of lower atmospheric pressure to higher atmospheric pressure (claim 1); and wherein further the non-flexing surface maintains the same form from prior to hot-filling or transport (claim 1).

With regard to claim 16, Jonas et al teach thermoforming the container (column 14, lines 1-5). Official notice is taken of the fact that it is well known to heat a plastic sheet to its VICAT temperature before thermoforming.

With regard to claim 17, Jonas et al teaches forming the container may comprise extrusion, injection molding, and blow molding (column 14, lines 1-5).

With regard to claim 18, Jonas et al teach a method for forming a plastic container with a selectively deformable surface (abstract), comprising: selecting at least one polymer for a plastic container (column 13, lines 57-68); and thermoforming a container from the heated polymer (column 14, lines 1-5); wherein the plastic container comprises: a mouth; a bottom surface; and a container wall between the mouth and the

bottom surface (column 8, lines 59-68), wherein one of the bottom surface or the container wall flexes inward into the cavity of the plastic container (column 5, lines 19-27); wherein further the inward flexing of the bottom surface of the container wall reduces a pressure differential between the inside of the container and atmospheric pressure when either the container is hot-filled with food product or when the container is transported from a locale of lower atmospheric pressure to higher atmospheric pressure (claim 1); and wherein further the non-flexing surface maintains the same form from prior to hot-filling or transport (claim 1). Official notice is taken of the fact that it is well known to heat a plastic sheet to its VICAT temperature before thermoforming.

With regard to claim 20, Jonas et al teach that the bottom surface flexes inward into the container cavity (column 5, lines 19-28).

9. Claims 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by McHenry et al (4,667,454).

With regard to claim 18, McHenry et al teach a method for forming a plastic container with a selectively deformable surface (abstract), comprising: selecting at least one polymer for a plastic container (column 4, lines 48-61); and thermoforming a container from the heated polymer (column 3, line 39); wherein the plastic container comprises: a mouth; a bottom surface; and a container wall between the mouth and the bottom surface (Figure 1A), wherein one of the bottom surface or the container wall flexes inward into the cavity of the plastic container (Figure 1B); wherein further the inward flexing of the bottom surface of the container wall reduces a pressure differential between the inside of the container and atmospheric pressure when either the container

is hot-filled with food product or when the container is transported from a locale of lower atmospheric pressure to higher atmospheric pressure (reduction of volume will inherently perform this task); and wherein further the non-flexing surface maintains the same form from prior to hot-filling or transport (Figure 1A and 1B). Official notice is taken of the fact that it is well known to heat a plastic sheet to its VICAT temperature before thermoforming.

With regard to claim 19, McHenry et al teach that the thickness of the container walls decreases from a point substantially at the mouth (figure 5, T2) to a point substantially at the bottom surface (figure 5, T5).

10. Claim 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Agrawal et al (5,234,126).

With regard to claim 18, Agrawal et al teach a method for forming a plastic container with a selectively deformable surface (abstract), comprising: selecting at least one polymer for a plastic container (abstract, polyester); and thermoforming a container from the heated polymer (column 6, lines 44-50); wherein the plastic container comprises: a mouth; a bottom surface; and a container wall between the mouth and the bottom surface (Figure 6), wherein one of the bottom surface or the container wall flexes inward into the cavity of the plastic container (abstract); wherein further the inward flexing of the bottom surface of the container wall reduces a pressure differential between the inside of the container and atmospheric pressure when either the container is hot-filled with food product or when the container is transported from a locale of lower atmospheric pressure to higher atmospheric pressure (reduction of volume will

inherently perform this task); and wherein further the non-flexing surface maintains the same form from prior to hot-filling or transport (Figure 1A and 1B). Official notice is taken of the fact that it is well known to heat a plastic sheet to its VICAT temperature before thermoforming.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jonas et al (5,234,126) in view of Hodson et al (US 2002/0187290).

With regard to claim 21, Jonas et al teach the invention of claim 20 as discussed above, but does not explicitly teach that the circumference of the mouth is greater than the circumference of the bottom surface. Hodson et al teaches a container for food storage that can be used with a hot fill application (paragraph 0057) in which the circumference of the mouth is greater than the circumference of the bottom surface (figure 3). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to create a container where the circumference of the mouth is greater than the circumference of the bottom in the process of Jonas et al. The motivation to do so would have been to facilitate easy removal of a semi-solid food product from the container.

With regard to claim 22, Jonas et al teach that the plastic/polypropylene (column 13, line 65) comprises a plastic suitable for solid phase pressure forming (column 14, line 5, thermoforming).

With regard to claim 23, Jonas et al teach the plastic further comprises polypropylene (column 13, line 65).

With regard to claim 24, Jonas et al teach the plastic further comprises a barrier enhancement agent (column 13, line 64, EVOH).

With regard to claim 25, Jonas et al teach the barrier enhancement agent comprises ethylene vinyl acetate-vinyl alcohol (column 13, line 64, EVOH).

With regard to claim 26, Hodson et al teach the plastic further comprises an adhesive suitable for solid phase pressure forming, polypropylene and EVOH (paragraph 0052).

13. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jonas et al (5,234,126) in view of Hodson et al (US 2002/0187290) and Hope et al (5,202,192).

With regard to claim 27, Jonas et al in view of Hodson et al teach the invention of claim 26 as discussed above, but do not explicitly teach that the adhesive contains an antioxidant. Hope et al teaches a plastic container comprising an adhesive blend containing an antioxidant (column 2, lines 66-68). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add an antioxidant to the adhesive taught by Hodson et al. The motivation to do so would have been protect the food contained in the container from oxidation.

14. Claims 29-31 are rejected under 35 U.S.C. 103(a) as unpatentable over Agrawal et al (5,234,126).

With regard to claim 29, Agrawal et al teach a range of preform, neck, wall, and bottom thicknesses that anticipate the ranges described by claim 29. Agrawal et al teach that the preform may be1250 to 5000 μm thick (column 6, lines 15-18), the wall thickness may be 250 to 900 μm thick, the bottom may be 250 to 1800 μm thick and the shoulder area may be 350-1250 μm thick (column 12, lines 52-61). For example, the equation would be satisfied if the preform were 1600 μm thick, the shoulder was 1250 μm thick, the wall was 600 μm thick and the bottom were 300 μm thick.

With regard to claim 30, Agrawal et al teach that the container does not have uniform wall thickness due to the differences in the amount of stretch in different areas. Stretching a preform with uniformly thick walls will result in a uniform decrease in thickness from the top to the bottom of the finished container.

With regard to claim 31, Agrawal et al teach the invention of claim 30 as discussed above, but does not explicitly disclose the thicknesses of 0.7 mm at the mouth, 0.28 mm near the bottom, and 0.16 mm at the bottom of the container. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used these thicknesses, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art and it is well known that the thickness of a container is a result effective variable where the result is the crush strength of the container. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Beck whose telephone number is 571-272-2942. The examiner can normally be reached on Monday - Friday, 8AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 517-272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DTB
May 12, 2005
DTB

MICHAEL P. COLAIANNI
SUPERVISORY PATENT EXAMINER